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OFFICE OF PETITIONS

In re Application of
Wingard et al.
Application No.09/634,045
Filed: August 8, 2000
Attorney Docket Number: 02998.P011
Title of Invention: LOGIC SYSTEM WITH
CONFIGURABLE INTERFACE

ON PETITION

This is a decision on the petition filed December 29, 2004, under 37 CFR 1.137(a) and in the alternative under 37 CFR 1.137(b) to revive the above-identified application. In the alternative

The petition to revive under 37 CFR § 1.137(a) is **DISMISSED**.

The petition to revive under 37 CFR §1.137(b) is **GRANTED**.

This above-identified application became abandoned for failure to timely file a proper reply to a final Office Action pursuant to 37 CFR §1.113. The final Office Action was mailed on April 19, 2004 and set a three (3) month shortened statutory period for reply. An amendment with a request for a one month extension of time was submitted on August 20, 2004 (certificate of mailing August 17, 2004). In response to the amendment an Advisory Action was mailed on October 18, 2004 indicating the amendment submitted on August 20, 2004 (certificate of mailing August 17, 2004) did not place the application in condition for allowance. Accordingly, this application became abandoned on August 19, 2004. This decision precedes the mailing of a Notice of Abandonment.

PETITION TO REVIVE UNDER 37 CFR § 1.137(a)

A grantable petition under 37 CFR § 1.137(a) must be accompanied by:

- (1) the required reply,¹
- (2) the petition fee,
- (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks items (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).² Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.³

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

² See MPEP 711(c) (III) (c) (2) for a discussion of the requirements for a showing of unavoidable delay.

³ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner asserts the application was unavoidably delayed because on or about October 29, 2004, Examiner Thompson told petitioner via a telephone conversation that she was going to send out a supplemental Advisory Action. Petitioner insists that he relied upon Examiner Thompson's statement and thus refrained from filing further response. On December 14, 2004, petitioner spoke to Examiner Thompson where she informed petitioner that she would not be sending out a supplemental Advisory Action. Petitioner argues that by the time the second conversation took place the application had passed into abandonment.

Petitioner's arguments have been considered but they are not persuasive. Petitioner's reliance upon a conversation with Examiner Thompson is not convincing because a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Further when the purported conversations took place on October 29, 2004 and December 14, 2004 the application was already in abandoned status.

Secondly, petitioner was informed in the Final Office Action and the Advisory Action that the statutory time period for reply could not be extended beyond the six months from the mailing of the Final Office Action. Pursuant to 37 CFR 1.116 (b), the admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. Further MPEP 711.03(c) is clear that an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, when the applicant simply permits the maximum extendable statutory period for reply to expire while awaiting a notice of allowance or other action.

Accordingly, petitioner has failed to provide sufficient arguments that warrant the finding of unavoidable delay within the meaning of 37 CFR 1.137(a).

PETITION TO REVIVE UNDER 37 CFR 1.137(b)

In the alternative, petitioner has requested the above petition be treated under 37 CFR 1.137(b).

The statement of unintentional delay presented in the petition does not comply with the current rule. Pursuant to 37 CFR 1.137(b)(3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" is required. However, the statement presented will be accepted and construed as the statement required by 37 CFR

1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The requirements for the filing of a grantable petition under 37 CFR §1.137(b) have been met. This Petition is hereby **Granted**.

Pursuant to petitioner's request deposit account 02-2666 will be charged the \$1500 unintentional petition fee.

This application is being forwarded to Technology Center 2800 for further processing of the appeal brief submitted with the instant petition.

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

A handwritten signature in black ink, appearing to read "Charlema R. Grant", is written over the printed name.

Charlema R. Grant

Petitions Attorney

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